

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered									
SERIAL NUMBER	85849487									
LAW OFFICE ASSIGNED	LAW OFFICE 105									
MARK SECTION (no change)										
ARGUMENT(S)										
<p style="text-align: center;"><u>REMARKS</u></p> <p>In furtherance of Applicant's arguments submitted to the Office on December 6, 2013, regarding the above-referenced Trademark Application for the applied-for mark RECON, the Applicant respectfully requests that the Examining Attorney reconsider her final refusal to register the applied-for mark under Section 2(d) of the Lanham Act, 15 U.S.C.A. § 1052(d), in light of the following comments:</p> <p style="text-align: center;"><u>The Cited Marks Are Entitled to a Narrow Scope of Protection</u></p> <p>The Examining Attorney has refused Applicant's mark RECON on the grounds that it is confusingly similar with the following previously registered trademarks (collectively, the "Cited Marks"):</p> <table><thead><tr><th><u>Mark / Reg. No.</u></th><th><u>Owner</u></th><th><u>Goods / Services</u></th></tr></thead><tbody><tr><td>RECON Reg. No.: 2,965,297</td><td>TRIMBLE NAVIGATION LIMITED</td><td>Impact, temperature, and vibration resistant, water-impervious, handheld computers for use in geographical information systems field work, agricultural and construction work, land surveying, public safety, field service, utilities, military and other outdoor or service-related applications.</td></tr><tr><td>RECON Reg. No.: 3,470,400</td><td>Austin Geomodeling, Inc.</td><td>3-D geological interpretation software, namely, software used on PC workstations by specific sectors of the oil and gas exploration and production industry to interpret geological measurements, namely, seismic and oil and gas well log data in an interactive,</td></tr></tbody></table>		<u>Mark / Reg. No.</u>	<u>Owner</u>	<u>Goods / Services</u>	RECON Reg. No.: 2,965,297	TRIMBLE NAVIGATION LIMITED	Impact, temperature, and vibration resistant, water-impervious, handheld computers for use in geographical information systems field work, agricultural and construction work, land surveying, public safety, field service, utilities, military and other outdoor or service-related applications.	RECON Reg. No.: 3,470,400	Austin Geomodeling, Inc.	3-D geological interpretation software, namely, software used on PC workstations by specific sectors of the oil and gas exploration and production industry to interpret geological measurements, namely, seismic and oil and gas well log data in an interactive,
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RECONHD
Reg. No.: 4,347,462

Ingrain, Inc.

3-D visualization environment, enabling the user to display polygonal representations of oil and gas well logs in combination with graphics texture representations of sub-surface seismic data, for the purpose of manually interpreting and defining a three-dimensional model of the subsurface geological layers.

Scientific imaging services in the nature of computed tomography images or scanning electron microscope images of subsurface drill cuttings from geologic formations, such services performed in a laboratory or at a drill site; scientific imaging in the nature of generating computed tomography images or scanning electron microscope images of drill cuttings.

Applicant respectfully states that consumer confusion is unlikely, because the coexistence of many “recon” marks for a wide variety of goods and services has diluted the Register. Even small distinctions between such marks are sufficient to avoid a likelihood of confusion.

The Cited Marks are entitled to only the narrowest scope of protection due to the co-existence of multiple marks that incorporate the term “*recon*” on the Register. Words with commonly understood meanings or that are highly suggestive in nature, as opposed to arbitrary terms, are the weakest of all recognized trademarks, because they do not readily distinguish the products to which they are applied from those of others. See King Candy Co. v. Eunice King’s Kitchen, Inc., 496 F.2d 1400 (C.C.P.A. 1974).

When a common term is used by unrelated entities for similar goods, the scope of protection afforded to any one trademark with such a term is limited. By virtue of its frequent usage, the common term in the mark does little to distinguish the products or services from those of others. See, e.g., King Candy Co. v. Eunice King’s Kitchen, Inc., 496 F.2d 1400 (C.C.P.A. 1974) Consumers instead rely on the other elements of the marks and their commercial impression as a whole to distinguish the marks. See Sure-Fit Products Co. v. Saltzson Drapery Co., 254 F.2d 158 (C.C.P.A. 1958).

In this instance, the term “*recon*” is popular and used by a number of unaffiliated third parties. As such, Applicant’s mark and the Cited Marks may co-exist without a likelihood of confusion because the Register is already crowded with “*recon*” formative marks for related goods and services. There are over 150 active registrations and applications on the Register containing the term “*recon*”, and over 45 active records in Class 09 containing the term “*recon*”.

The Office and the courts have repeatedly recognized the absence of likely confusion arising from the concurrent use of weak marks that contain frequently used elements. See *Sure-Fit*, 117 U.S.P.Q. at 297; *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445 (9th Cir. 1988) (“In a ‘crowded’ field of similar marks, each member of the crowd is relatively ‘weak’ in its ability to prevent use by others in the crowd.”).

Here, the Register is crowded with *recon* formative marks. This demonstrates that: (i) such marks have been frequently adopted by unrelated entities as suggestive for a number of related goods or services; and (ii) that the Office has consistently taken the position that such marks have a narrow scope of protection and can coexist without risk of confusion, because the other elements of the marks sufficiently distinguish the marks. That the Examining Attorney cited three trademarks owned by different parties underscores the crowded field of *recon* formative marks.

Accordingly, the Cited Marks are entitled to a narrow scope of protection and are capable of coexisting with Applicant’s RECON trademark on the Principal Register and in the marketplace without any likelihood of confusion.

SIGNATURE SECTION

RESPONSE SIGNATURE	/ssc/
SIGNATORY'S NAME	Sunisha S. Choksi
SIGNATORY'S POSITION	Attorney of record, Texas bar member
SIGNATORY'S PHONE NUMBER	(713) 640-5933
DATE SIGNED	07/07/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Jul 07 23:56:18 EDT 2014
TEAS STAMP	USPTO/RFR-50.171.99.139-2 0140707235618505701-85849 487-500cbe7fa43bfbf7dcfe5 5117fe437c6bfb2b3ea686bde 2b8f0ced39bb11ec1-N/A-N/A -20140707235427380399

To the Commissioner for Trademarks:

Application serial no. **85849487** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

REMARKS

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The Cited Marks Are Entitled to a Narrow Scope of Protection

The Examining Attorney has refused Applicant's mark RECON on the grounds that it is confusingly similar with the following previously registered trademarks (collectively, the "Cited Marks"):

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /ssc/ Date: 07/07/2014

Signatory's Name: Sunisha S. Choksi

Signatory's Position: Attorney of record, Texas bar member

Signatory's Phone Number: (713) 640-5933

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85849487

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